

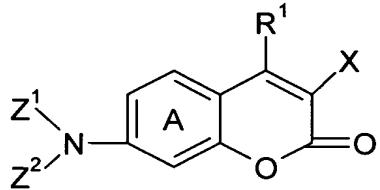
REMARKS

In the Office Action of September 15, 2005, the Examiner presented a 15-way Restriction Requirement and an Election of Species Requirement. In response Applicants hereby elect Group I (see, e.g., Formula I of claim 1) as the elected invention, and select *N*-(3-cyclopentyloxy-4-methoxyphenyl)-*N*-(1-oxy-3-pyridylmethyl)-3-aminobenzoic acid as the elected species (see, e.g., compound (j) on page 31). Applicants, of course, reserve the right to file divisional applications directed to non-elected subject matter. Moreover, applicants respectfully request reconsideration of the Restriction.

With regards to Groups IV, VII, X, and XIII, all of these groups are directed to methods of use of the compounds of elected Group I. Upon determination that the subject matter of Group I is allowable, applicants will request rejoinder of Groups IV, VII, X, and XIII, pursuant to MPEP §821.04.

With regards to formulas II and III of claim 1, these formulas exhibit fused ring structures rather than the R¹O- and R²O- substituents of formula I. In this regard, the decision in *In re Harnisch*, 206 USPQ 300 (CCPA 1980) is relevant.

In *Harnisch*, the claimed genus of compounds was defined by the following formula:



In this formula, Z¹ was defined as being H, alkyl, cycloalkyl, aralkyl, aryl or a 2- or 3-membered alkylene radical connected to the 6-position of the coumarin ring. Z² was defined as being H, alkyl, cycloalkyl, or a 2- or 3-membered alkylene radical connected to the 8-position of the coumarin ring. **In addition, Z¹ and Z² together with the nitrogen atom could represent an optionally benz-fused heterocyclic ring which "like ring A and the alkyl, aralkyl,**

cycloalkyl, and aryl radicals mentioned, can carry further radicals customary in dye-stuff chemistry."

Thus, as can be seen, the definitions in *Harnisch* of Z¹ and Z² encompassed a very wide variety of structures including various nitrogen containing heterocyclic structures such as morpholinyl, piperidyl, piperazinyl, etc. Yet, the Court in *Harnisch* reversed an improper Markush rejection noting that the claimed compounds were dyes and that the subgenus claimed was not repugnant to scientific classification.

In addition, applicants respectfully submit that 35 USC §121 does **not** permit restriction within a single claim (except in one specific circumstance described below) as clearly indicated by the court in *In re Weber et al.*, 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim "be divided up and presented in several applications" and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate "the basic right of the Applicant to claim his invention as he chooses." [*Weber* at 332]

In view of the above remarks, applicants respectfully request that the Restriction as to Groups I-III be withdrawn and that the entire scope of claim 1 be examined together.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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